

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested.

Claims 1 to 24 are currently pending in the application. Claims 1 to 21 (in part) and 22 to 24 have been withdrawn from consideration as drawn to non-elected subject matter. Claims 1 to 21 have been rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,831,093 (Scanlan). Claims 1 to 21 have been rejected as obvious over Scanlan pursuant to 35 U.S.C. § 103. Claim 17 has been rejected for indefiniteness under 35 U.S.C. § 112, second paragraph. No claim has been allowed. All rejections are traversed.

This Amendment cancels Claims 1 to 24 and adds new Claims 25 and 26. Support for new Claims 25 and 26 is found at page 93 (Ex. 94), page 94 (Ex. 95), page 95 (Ex. 98), page 97 (Exs. 102, 103 and 104) and Claims 17 and 18. New Claims 25 and 26 are directed to "Elected and Examined Subject Matter" as set forth on page 4 of the Office Action. The instant claim amendments are being made in order to advance prosecution of the subject application and should in no way be construed as an admission on the part of the Applicants that Scanlan is "prior art". Applicants reserve the right to prosecute canceled subject matter in one or more future continuation or divisional applications.

With respect to anticipation over Scanlan, Claims 25 and 26 are directed to six compounds that are not taught or suggested by Scanlan. As Scanlan fails to teach each and every element of the claimed subject matter, the subject matter of new Claims 25 and 26 is novel.

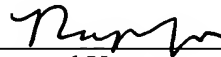
Nor would Scanlan render the compounds of Claims 25 and 26 obvious. The claimed compounds have three substituents on the methyl group attached at the 5-position of the 1H-benzo[f]indazole core. None of the specific compounds taught by Scanlan have three substituents at this position. Furthermore, the generic disclosure taught by Scanlan does not allow for tri-substitution at this position. Thus, Scanlan in no way teaches or suggests tri-substituted methyl compounds as claimed in new Claims 25 and 26. One having ordinary skill in the art with knowledge of Scanlan would in no way be motivated to make the claimed compounds and there is absolutely no teaching, suggestion or motivation provided by Scanlan that such a chemical modification can or should be made. As a result, the compounds of Claims 25 and 26 are in no way obvious over Scanlan.

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With respect to the 35 U.S.C. § 112, second paragraph, rejection for lack of antecedent basis, Claims 25 and 26 are each independent claims. As there cannot be any antecedent basis issues, the alleged 35 U.S.C. § 112, second paragraph issue raised by the Examiner is moot.

Applicants respectfully submit that the application is in condition for allowance and passage thereto is earnestly requested. Any additional fees required in connection with this Amendment may be taken from Merck Deposit Account No. 13-2755. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

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